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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,633	12/17/2001	Scott E. Silver	500035.401	2741
500	7590	09/22/2004		
SEED INTELLECTUAL PROPERTY LAW GROUP PLLC 701 FIFTH AVE SUITE 6300 SEATTLE, WA 98104-7092				
			EXAMINER DICUS, TAMRA	
			ART UNIT 1774	PAPER NUMBER

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

S.C.

Office Action Summary	Application No. 10/024,633	Applicant(s) SILVER ET AL.	
	Examiner Tamra L. Dicus	Art Unit 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The 112 rejection is withdrawn due to Applicant's amendments.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 24-27, 30, 33-37, and 39-43 stand rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,140,412 to Saitoh et al. in view of USPN 6,596,805 Nigam et al. for reasons of record mailed April 5, 2004.

4. Claims 28-29, 31-32, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,140,412 to Saitoh et al. in view of USPN 6,596,805 Nigam et al. and further in view of USPN 6,677,006 to Otani et al. for reasons of record mailed April 5, 2004.

Response to Arguments

Applicant's arguments filed 06-17-04 have been fully considered but they are not persuasive. Applicant's arguments are directed toward the use of the invention and its capability of performing in conjunction with a photocopier or laser printer. Applicant argues water-based inks could not be used with photocopiers or laser printers and would ultimately "totally fail"

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because the invention sheet does not absorb water and “could not ink jet print with inks” because a durable weatherproof coating layer. The Applicant has not provided a persuasive argument because the combination has the same structure as the instant invention, providing a waterproof agent incorporated in the sheet. While the combination is toward an ink jet sheet, Applicant merely claims a weatherproof sheet with additives. The combination reads on a weatherproof sheet as Saitoh provides for a waterproof agent (embraces weatherproof) and all of the ingredients Applicant uses, besides the styrene and acrylic monomer and wax, which is provided for by Nigam. While Applicant claims a “weatherproof” sheet, Applicant has not claimed a “water repellant” sheet as argued. The claimed invention is substantially identical to the combination of Saitoh and Nigam, therefore, it would function in the same manner. At col. 4, lines 60-62 of Saitoh, the coating amount of the waterproofing agent is $0.1-10 \text{ g/m}^2$, which falls within Applicant’s range of $3.7-5.6 \text{ g/m}^2$ per instant claim 27. Wood pulp fibers (cellulosic fibers) are also included in the paper at col. 4, line 66 of Saitoh (instant claim 40). Applicant has not presented factual evidence to the contrary to show the combination could not perform as Applicant intends. If Applicant believes the claimed invention is different, factual evidence should be provided. Further, to the use and capability of performing with the use of copiers and printers is to intended use and is not afforded patentable weight. The preamble of the claim is a “weatherproof sheet”, not a photocopier or laser printed sheet. The Applicant may amend the claims to limit the sheet to a photocopier or laser printed sheet if so desired. Applicant further argues the combination would be inoperative. The Examiner does not agree. The combination would not be inoperable because while the combination may have a different result, the Applicant has not shown it won’t work at all. It is unnecessary, however, that inventions of

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references be physically combinable to render obvious an applicant's invention. *In re Sneed*, 710 F.2d 1544, 1550, 218. The test for obviousness is not whether the features of a reference may be bodily incorporated into the structure of another reference, but what the combined teachings of those references would have suggested to those of ordinary skill in the art. *In re Keller*, 642 F.2d 413, 425, 208. Thus, Saitoh does not teach away from a weatherproof coating because Saitoh teaches the use of the coating for ink jet printing paper. The paper sheet of the combination includes all the limitations of the claimed invention, thus whether the paper sheet is used as an ink jet printing paper or for a photocopier or laser printer is of no consequence. As previously set forth, that a sheet is able to be printed fixedly and legibly bearing images directly thereon by means of the photocopier or laser printer or having dimensions suitable for printing to produce an architectural drawing is not germane since it has been held that an element that is "being able to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138. Also note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Applicant points to citations in the specification, however, while the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). If Applicant desires to include language from the specification, the Applicant has the right to include that language from the specification into the claims by way of amendment.

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Applicant argues Otani incorporates an ink-receiving layer and thus cannot be used to teach the instant invention because the ink is absorbed by paper. This argument is not persuasive because the claims do not exclude ink or an ink receiving layer from being present on the sheet as the instant claims include "comprising" language. A *prima facie* case has been established, and therefore the burden shifts to the Applicant to submit additional objective evidence of nonobviousness, such as comparative test data showing that the claimed invention possesses improved properties not expected by the prior art. Until the Applicant has convincingly argued or has provided evidence to the contrary, the rejections are maintained.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

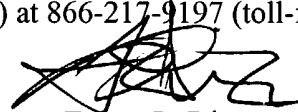
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tamra L. Dicus
Examiner
Art Unit 1774

September 14, 2004



RENA DYE
SUPERVISORY PATENT EXAMINER
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